

REMARKS

The Examiner finds the Appeal Brief filed July 26, 2004 defective. It is respectfully submitted that, other than the Grouping of Claims section of the Appeal Brief, the Appeal Brief complies with the mandates of 37 C.F.R. §1.192, as in force at the time of filing of the Appeal Brief, as well as the mandate of 37 CFR §41.37, currently in force, and thus is not defective.

Regarding the “Related Appeals And Interferences” section of the Appeal Brief, the Examiner argues that only those appeals involving other applications which may be related to present application under appeal should be listed therein. Further, the Examiner argues “[t]his listing should not include submissions of previous notices of appeal and appeal briefs in the present application, which are now moot..” Regarding the “Status Of Amendments” section of the Appeal Brief, the Examiner argues that only those amendments submitted after the final rejection, not those submitted prior to final rejection, should be listed therein.

It is respectfully submitted that the Examiner’s position is contrary to the requirements of 37 C.F.R. §1.192 in force at the time of filing of the Appeal Brief, as well as the requirements of 37 C.F.R. §41.37 currently in force. More particularly, 37 C.F.R. §1.192 required that an Appeal Brief include the following sections: (1) Real Party In Interest; (2) Related Appeals And Interferences; (3) Status Of Claims; (4) Status Of Amendments; (5) Summary Of Invention; (6) Issues; (7) Grouping Of Claims; (8) Argument; and (9) Appendix Of Claims. New 37 C.F.R. §41.37, replacing 37 C.F.R. §1.192, requires that an Appeal Brief include the following sections: (1) Real Party In Interest; (2) Related Appeals And Interferences; (3) Status Of Claims; (4) Status Of Amendments; (5) Summary Of Invention; (6) Grounds Of Rejection To Be Reviewed; (7) Argument; (8) Appendix Of Claims; and two new appendices. Thus, the

“Grouping of Claims” section of 37 C.F.R. §1.192 is no longer required, and the “Issues” section of 37 C.F.R. §1.192 has been replaced by the “Grounds Of Rejection To Be Reviewed” section of 37 C.F.R. §41.37.

Both 37 C.F.R. §1.192 and 37 C.F.R. §41.37 set a minimum threshold for the contents of an Appeal Brief. As explicitly stated in the Manual of Patent Examining Procedure, §1206 – Appeal Brief Content, 37 C.F.R. §1.192 “merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable. ... A brief is in compliance with 37 C.F.R. §1.192(c) as long as it includes items (1) to (9) in the order set forth.” Thus, the inclusion of information regarding prior appeals in the present application, and the inclusion of information regarding amendments made prior to the final rejection do not render the Appeal Brief Defective. If the Examiner should maintain that the Appeal Brief is defective for the above noted reasons, it is respectfully requested that the Examiner identify the rule upon which the Examiner relies.

The Examiner also argues that the Appeal Brief is defective because “ ‘the Brief Description of the Reference’ and ‘The Rejection’ should be contained in the Argument section. The listing of Issues should be followed by the Grouping of Claims.” As best understood, the Examiner objects to the “Brief Description of the Reference” and the “Rejection” portions of the Appeal Brief being distinct sections of the Appeal Brief. As discussed above, an Appeal Brief may contain any information an appellant considers “necessary or desirable”, MPEP §1206 – Appeal Brief Content. It is respectfully submitted that the applicants consider the “Brief Description of the Reference” and the “Rejection” sections of the Appeal brief both necessary and desirable, and as such, inclusion of these sections does not render the Appeal Brief

defective. Each of the sections of an Appeal Brief required under 37 CFR §1.192, the rule applicable at the time the Appeal Brief was filed, are included in the Appeal Brief in the order specified by that rule. If the Examiner should maintain that the Appeal Brief is defective because of the inclusion of the "Brief Description of the Reference" and the "Rejection" sections, it is respectfully requested that the Examiner identify the rule upon which the Examiner relies.

The Examiner also argues that the "Grouping Of Claims" section is defective. The "Grouping of Claims" section is amended in the attached Corrected Appeal Brief to address the Examiner's concerns regarding the editorial errors. However, as discussed above, it should be noted that a Grouping of Claims" section is no longer required under 37 C.F.R. §41.37. Thus, should the Examiner maintain that the now amended "Grouping Of Claims" section renders the Appeal Brief defective, such an argument is moot in view of new 37 C.F.R. §41.37.

In view of the above, it is respectfully requested that the Examiner withdraw the Notice of Defective Appeal Brief. Furthermore, as should be understood from the Corrected Appeal Brief, the rejection of the claims is in error and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with

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the filing of this paper, including extension of time fees, to Deposit Account 01-2135
and please credit any excess fees to such deposit account.

Respectfully Submitted,

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